

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:
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PCT

NOTIFICATION OF TRANSMITTAL OF
INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Rule 71.1)

Date of mailing
(day/month/year)

08 AUG 2005

Applicant's or agent's file reference

2003/01-PCT

IMPORTANT NOTIFICATION

International application No.

PCT/US04/15082

International filing date (day/month/year)

13 May 2004 (13.05.2004)

Priority date (day/month/year)

15 May 2003 (15.05.2003)

Applicant

INVISTA TECHNOLOGIES S.A.R.L.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices)(Article 39(1))(see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the *PCT Applicant's Guide*.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

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Valerie Bell-Horne
for

Form PCT/IPEA/416 (January 2004)

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AUG 12 2005

DOUGHERTY, CLEMENTS, HOFER & BERNARD

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

| | | | | | | | | | | | | | | | | | | | |
|--|---|---|-----------------------|---|---------------------|-------------------------------------|----------|---|--|-------------------------------------|----------------------------|---|---|-------------------------------------|-------------------------|--------------------------------------|--|---------------------------------------|---|
| Applicant's or agent's file reference 2003/01-PCT | FOR FURTHER ACTION | | See Form PCT/IPEA/416 | | | | | | | | | | | | | | | | |
| International application No. PCT/US04/15082 | International filing date (day/month/year) 13 May 2004 (13.05.2004) | Priority date (day/month/year) 15 May 2003 (15.05.2003) | | | | | | | | | | | | | | | | | |
| International Patent Classification (IPC) or national classification and IPC IPC(7): C07C 69/00 and US Cl.: 560/139 | | | | | | | | | | | | | | | | | | | |
| Applicant INVISTA TECHNOLOGIES S.A.R.L. | | | | | | | | | | | | | | | | | | | |
| <ol style="list-style-type: none"> 1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36. 2. This REPORT consists of a total of <u>4</u> sheets, including this cover sheet. 3. This report is also accompanied by ANNEXES, comprising: <ol style="list-style-type: none"> a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of ___ sheets, as follows: <div style="margin-left: 20px;"> <input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions). <input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box. </div> b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions). 4. This report contains indications relating to the following items: <table style="margin-left: 20px; border: none;"> <tr> <td><input checked="" type="checkbox"/> Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/> Box No. II</td> <td>Priority</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/> Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/> Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/> Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/> Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table> | | | | <input checked="" type="checkbox"/> Box No. I | Basis of the report | <input type="checkbox"/> Box No. II | Priority | <input checked="" type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability | <input type="checkbox"/> Box No. IV | Lack of unity of invention | <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement | <input type="checkbox"/> Box No. VI | Certain documents cited | <input type="checkbox"/> Box No. VII | Certain defects in the international application | <input type="checkbox"/> Box No. VIII | Certain observations on the international application |
| <input checked="" type="checkbox"/> Box No. I | Basis of the report | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> Box No. II | Priority | | | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention | | | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> Box No. VI | Certain documents cited | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application | | | | | | | | | | | | | | | | | | |
| Date of submission of the demand 10 December 2004 (10.12.2004) | | Date of completion of this report 28 June 2005 (28.06.2005) | | | | | | | | | | | | | | | | | |
| Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230 | | Authorized officer Samuel A. Barts <i>Valerie Bell-Harris</i> Telephone No. (571) 222-1600 | | | | | | | | | | | | | | | | | |

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:

- ☐ international search (under Rules 12.3 and 23.1(b))
☐ publication of the international application (under Rule 12.4)
☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

☒ the international application as originally filed/furnished

☒ the description:

pages 1-14 _____ as originally filed/furnished
pages* NONE _____ received by this Authority on _____
pages* NONE _____ received by this Authority on _____

☒ the claims:

pages 15-17 _____ as originally filed/furnished
pages* NONE _____ as amended (together with any statement) under Article 19
pages* NONE _____ received by this Authority on _____
pages* NONE _____ received by this Authority on _____

☐ the drawings:

pages NONE _____ as originally filed/furnished
pages* NONE _____ received by this Authority on _____
pages* NONE _____ received by this Authority on _____

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages none _____
☒ the claims, Nos. none _____
☒ the drawings, sheets/figs none _____
☒ the sequence listing (*specify*): none _____
☒ any table(s) related to the sequence listing (*specify*): none _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages _____
☐ the claims, Nos. _____
☐ the drawings, sheets/figs _____
☐ the sequence listing (*specify*): _____
☐ any table(s) related to the sequence listing (*specify*): _____

** If item 4 applies, some or all of those sheets may be marked "superseded."*

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application
☒ claims Nos. 4,6,7,9-11 and 21-25

because:

- ☐ the said international application, or the said claim Nos. _____ relate to the following subject matter which does not require an international preliminary examination (*specify*):

- ☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 4,6,7,9,10 and 21-25 are so unclear that no meaningful opinion could be formed (*specify*):

6¹² Claims 4, 6 and 7 depend on claim 1, which is drawn to an ester. However, the said claims contain limitation directed to further limit a composition. Thus, it is unclear if the invention is a composition or a compound. Since the independent claims is drawn to a compound, it is unclear what is the composition that is being limited in the said claims, thus the said composition claims are unsearchable.

Claims 9, 10 and 11 depend on an independent claim 8, which is drawn to a method of preparation. Nonetheless, claims 9,10 and 11 are drawn to limit a product. Thus it is unclear if the invention is a compound or method or preparation. Therefore claims 9, 10, and 11 are unclear and unsearchable.

Claims 21-25 are directed to a composition nonetheless it is unclear what are the components of the said composition. For instance the term catalyst embraces multiple possibilities and it is unclear what can satisfy the limitations of the said composition. Since the components of the said composition are not clearly defines the said composition is unsearchable.

- ☐ the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for said claims Nos. _____

- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

| | | |
|----------------------------|--------------------------|-----------------------------------|
| the written form | <input type="checkbox"/> | has not been furnished |
| | <input type="checkbox"/> | does not comply with the standard |
| the computer readable form | <input type="checkbox"/> | has not been furnished |
| | <input type="checkbox"/> | does not comply with the standard |

- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.
- ☐ See Supplemental Box for further details.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US04/15082**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

| | | |
|-------------------------------|-----------------------------|-----|
| Novelty (N) | Claims <u>14-20</u> | YES |
| | Claims <u>1-3,5,8,12-13</u> | NO |
| Inventive Step (IS) | Claims <u>14-20</u> | YES |
| | Claims <u>1-3,5,8,12-13</u> | NO |
| Industrial Applicability (IA) | Claims <u>1-3,5,8,12-20</u> | YES |
| | Claims <u>NONE</u> | NO |

2. Citations and Explanations (Rule 70.7)

Claims 1-3, 5, 8, 12 and 13 lack an inventive step under PCT Article 33(3) as being obvious over Mozingo et al, as described in CAPLUS AN 1948:10287 for JACS 70, pp 229-231 (1948). Mozingo et al disclosed methyl p-toluate having a registry number 99-75-2.

Claims 1-3, 5, 8, 12 and 13 lack novelty under PCT Article 33(2) as being anticipated by Arendt et al, US patent 5990214. Arendt discloses diethylene glycol and other glycol esters of toluic acid its use as plasticizers.

Claims 14-20 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest the composition described in the said claims.

Claims 1, 2, 3, 5, 8, 12, 13 and 14-20 meet the criteria set out in PCT Article 33(4), and thus meet industrial applicability because the subject matter claimed can be made or used in industry.

----- NEW CITATIONS -----